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PFIZER INC.  
PATENT DEPARTMENT, MS8260-1611  
GROTON CT 06340

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**FEB 09 2009**

**OFFICE OF PETITIONS**

In re Application of :  
Becker, et al.  
Application No. 10/722,104 : LETTER REGARDING PATENT  
Filed: November 25, 2003 : TERM ADJUSTMENT  
Attorney Docket No. PC27788 :  
For: HETEROARYLSULFONYLMETHYL :  
HYDROXAMIC ACIDS AND AMIDES AND :  
THEIR USE AS PROTEASE :  
INHIBITORS :  
:

This decision is in response to the "COMMUNICATION," filed June 12, 2008. Applicants disclose that the patent term adjustment (PTA) indicated on the Determination of Patent Term Adjustment may extend the term of this patent by too many days because of the Office's failure to calculate the number of days for applicants delay correctly.

The request for review of the patent term adjustment is GRANTED.

The Office has updated the PAIR screen to reflect that the correct Patent Term Adjustment (PTA) determination at the time of the mailing of the Notice of Allowance is TWO HUNDRED SIXTY ONE (261) days. A copy of the updated PAIR screen, showing the correct determination, is enclosed.

On July 7, 2007, the Office mailed a Notice of Allowance with the Determination of Patent Term Adjustment under 35 U.S.C. 154(b) in the above-identified application. The Notice stated that the patent term adjustment to date is 330 days. Applicants disclose that this may be incorrect given the filing of a Request for Continued Examination, filed on September 19, 2007,

and the delayed payment of the issue fee and submission of a Rule 137(b) petition on June 3, 2008.

A review of the application history confirms that an incorrect number of days was determined for applicants delay. 37 CFR 1.704(b) states that the period of adjustment under 35 U.S.C. 1.703 shall be reduced by any periods of time in excess of three months that are taken to reply to an action by the Office making any rejection, objection, argument or other request. In the present case, a final Office action was mailed on April 12, 2007. A response in compliance with §1.113(c), a request for continued examination (RCE) and amendment, was not filed until September 19, 2007, three months and 69 days later. Pursuant to 37 CFR 1.704(b), a period of reduction of 69 days is being entered.

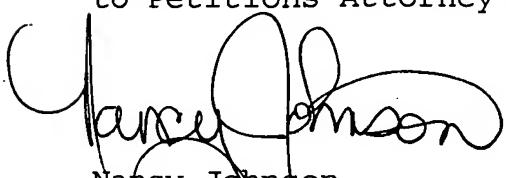
In view thereof, this correct patent term adjustment at the time of the mailing of the Notice of Allowance is two hundred sixty-one (261) days.

With respect to the delay in payment of the issue fee and the abandonment of the application after the mailing of the Notice of Allowance, these calculations are not considered under the initial Determination of Patent Term Adjustment sent with the Notice of Allowance. The revised patent term adjustment indicated in the Issue Notification (and on the patent) is revised in light of applicant and Office delays after the mailing of the Notice of Allowance. If the revised patent term adjustment does not properly consider applicants' delay in paying the issue fee and/or in filing a grantable revival petition, then applicants should file another candor letter.

As this letter was submitted to advise the Office of an error in applicants' delay, the Office will not assess the \$200.00 fee under 37 CFR 1.18(e). The Office thanks applicants for their good faith and candor in bringing this to the attention of the Office.

The Change of Correspondence Address filed on June 3, 2008 has not been accepted because Attorney Engelmann is not an attorney of record. A courtesy copy of this decision is being mailed to practitioner. However, any future correspondence regarding this application will be mailed to the address of record.

Telephone inquiries concerning this decision should be directed to Petitions Attorney Shirene Willis Brantley at (571) 272-3230.



Nancy Johnson  
Senior Petitions Attorney  
Office of Petitions

CC: PHARMACIA & UPJOHN  
7000 PORTAGE ROAD  
KZO-300-104  
KALAMAZOO, MI 49001

Enclosure: Copy of Revised PAIR Screen

Day : Thursday

## PALM INTRANET

Date: 2/5/2009

Time: 16:30:59

## PTA Calculations for Application: 10/722104

|                          |            |                         |     |
|--------------------------|------------|-------------------------|-----|
| Application Filing Date: | 11/25/2003 | PTO Delay (PTO):        | 422 |
| Issue Date of Patent:    |            | Three Years:            | 0   |
| Pre-Issue Petitions:     | 0          | Applicant Delay (APPL): | 92  |
| Post-Issue Petitions:    | 0          | Total PTA (days):       | 261 |
| PTO Delay Adjustment:    | -69        |                         |     |

## File Contents History

| Number | Date       | Contents Description                                       | PTO | APPL | START |
|--------|------------|--|-----|------|-------|
| 64     | 02/05/2009 | ADJUSTMENT OF PTA CALCULATION BY PTO                       |     | 69   |       |
| 54     | 12/07/2007 | MAIL NOTICE OF ALLOWANCE                                   |     |      |       |
| 53     | 11/06/2007 | ISSUE REVISION COMPLETED                                   |     |      |       |
| 52     | 11/06/2007 | DOCUMENT VERIFICATION                                      |     |      |       |
| 51     | 12/06/2007 | NOTICE OF ALLOWANCE DATA VERIFICATION COMPLETED            |     |      |       |
| 50     | 12/06/2007 | CASE DOCKETED TO EXAMINER IN GAU                           |     |      |       |
| 49     | 12/04/2007 | NOTICE OF ALLOWABILITY                                     |     |      |       |
| 45     | 09/27/2007 | DATE FORWARDED TO EXAMINER                                 |     |      |       |
| 44     | 09/19/2007 | AMENDMENT SUBMITTED/ENTERED WITH FILING OF CPA/RCE         |     |      |       |
| 43     | 09/27/2007 | DATE FORWARDED TO EXAMINER                                 |     |      |       |
| 42     | 09/19/2007 | REQUEST FOR CONTINUED EXAMINATION (RCE)                    |     |      |       |
| 41     | 09/27/2007 | DISPOSAL FOR A RCE/CPA/129 (EXPRESS ABANDONMENT IF CPA)    |     |      |       |
| 40     | 09/19/2007 | WORKFLOW - REQUEST FOR RCE - BEGIN                         |     |      |       |
| 39     | 07/12/2007 | PARALEGAL TD ACCEPTED                                      |     |      |       |
| 38     | 07/12/2007 | PARALEGAL TD ACCEPTED                                      |     |      |       |
| 37     | 07/06/2007 | TERMINAL DISCLAIMER FILED                                  |     |      |       |
| 36     | 07/12/2007 | MAIL MISCELLANEOUS COMMUNICATION TO APPLICANT              |     |      |       |
| 35     | 07/11/2007 | MISCELLANEOUS COMMUNICATION TO APPLICANT - NO ACTION COUNT |     |      |       |
| 34     | 07/06/2007 | IMPROPER REQUEST FOR CONTINUED EXAMINATION                 |     |      |       |
| 33     | 07/06/2007 | WORKFLOW - REQUEST FOR RCE - BEGIN                         |     |      |       |
| 32     | 04/12/2007 | MAIL FINAL REJECTION (PTOL - 326)                          |     |      |       |

|      |            |  |     |    |    |
|------|------------|--|-----|----|----|
| 31   | 04/05/2007 | FINAL REJECTION  |     |    |    |
| 30   | 02/01/2007 | DATE FORWARDED TO EXAMINER   |     |    |    |
| 29   | 01/17/2007 | RESPONSE AFTER NON-FINAL ACTION  |     | 92 | 26 |
| 28   | 01/17/2007 | REQUEST FOR EXTENSION OF TIME - GRANTED  |     |    |    |
| 27   | 07/27/2006 | CASE DOCKETED TO EXAMINER IN GAU   |     |    |    |
| 26   | 07/17/2006 | MAIL NON-FINAL REJECTION   |     |    |    |
| 25   | 06/12/2006 | NON-FINAL REJECTION  |     |    |    |
| 24   | 04/24/2006 | DATE FORWARDED TO EXAMINER   |     |    |    |
| 23   | 04/17/2006 | RESPONSE TO ELECTION / RESTRICTION FILED   |     |    |    |
| 22   | 03/23/2006 | MAIL RESTRICTION REQUIREMENT   | 422 |    | -1 |
| 21   | 03/20/2006 | REQUIREMENT FOR RESTRICTION / ELECTION   |     |    |    |
| 20   | 01/31/2005 | INFORMATION DISCLOSURE STATEMENT<br>CONSIDERED   |     |    |    |
| 19   | 01/31/2005 | INFORMATION DISCLOSURE STATEMENT<br>CONSIDERED   |     |    |    |
| 18   | 01/11/2006 | CASE DOCKETED TO EXAMINER IN GAU   |     |    |    |
| 17   | 03/18/2005 | CORRESPONDENCE ADDRESS CHANGE  |     |    |    |
| 16.7 | 01/31/2005 | INFORMATION DISCLOSURE STATEMENT (IDS)<br>FILED  |     |    |    |
| 16   | 01/31/2005 | INFORMATION DISCLOSURE STATEMENT (IDS)<br>FILED  |     |    |    |
| 15.7 | 01/31/2005 | INFORMATION DISCLOSURE STATEMENT (IDS)<br>FILED  |     |    |    |
| 15   | 01/31/2005 | INFORMATION DISCLOSURE STATEMENT (IDS)<br>FILED  |     |    |    |
| 14   | 04/14/2004 | IFW TSS PROCESSING BY TECH CENTER<br>COMPLETE  |     |    |    |
| 13   | 04/14/2004 | CASE DOCKETED TO EXAMINER IN GAU   |     |    |    |
| 12   | 04/02/2004 | APPLICATION RETURN FROM OIPE   |     |    |    |
| 11   | 04/02/2004 | APPLICATION RETURN TO OIPE   |     |    |    |
| 10   | 04/02/2004 | APPLICATION DISPATCHED FROM OIPE   |     |    |    |
| 9    | 04/02/2004 | APPLICATION IS NOW COMPLETE  |     |    |    |
| 8    | 03/24/2004 | ADDITIONAL APPLICATION FILING FEES   |     |    |    |
| 7    | 03/24/2004 | SMALL ENTITY STATEMENT (37 CFR 1.27)   |     |    |    |
| 6    | 03/24/2004 | A STATEMENT BY ONE OR MORE INVENTORS<br>SATISFYING THE REQUIREMENT UNDER 35 USC<br>115, OATH OF THE APPLIC |     |    |    |
| 5    | 02/26/2004 | NOTICE MAILED--APPLICATION INCOMPLETE--<br>FILING DATE ASSIGNED  |     |    |    |

|   |            |                                      |  |  |  |
|---|------------|--------------------------------------|--|--|--|
| 4 | 02/06/2004 | CLEARED BY OIPE CSR                  |  |  |  |
| 3 | 02/06/2004 | CASE CLASSIFIED BY OIPE              |  |  |  |
| 2 | 12/24/2003 | IFW SCAN & PACR AUTO SECURITY REVIEW |  |  |  |
| 1 | 11/25/2003 | INITIAL EXAM TEAM NN                 |  |  |  |

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#### **EXPLANATION OF PTA CALCULATION**

#### **EXPLANATION OF PTE CALCULATION**

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